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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,652	05/17/2001	Koichiro Kashiwagi	NEC N01270	3896
27667	7590	11/02/2004	EXAMINER	
HAYES, SOLOWAY P.C. 130 W. CUSHING STREET TUCSON, AZ 85701			SINGH, RAMNANDAN P	
			ART UNIT	PAPER NUMBER
			2644	

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/859,652

Applicant(s)

KASHIWAGI, KOICHIRO

Examiner

Ramnandan Singh

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-16 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on July 20, 2004 have been considered but are moot in view of the new ground(s) of rejection.

### ***Priority***

2. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.
3. A certified English translation of Applicant's underlying Japanese Application has NOT been received along with the amendment filed on July 20, 2004.

### **4. Status of Claims**

Claims 1, 2, 4, 6-7, 9-10, 12, 14-15 are amended.

Claims 1-16 are pending.

### **5. Change of Scope**

With the amendment to the claims, a new search for prior art has been necessitated. As a result, new grounds of rejection are made.

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***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-7, 9-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Peterson et al [US 6,385,303 B1].

Regarding claim 1, Peterson et al teach a telephone set (100) , as shown in Fig. 11, comprising:

- at least one handset (110);
- at least one speaker (920) external to the handset;
- at least one microphone (930) external to the handset; and
- a notifying/instructing unit (900) used to make an instruction to continuously notify a user via the speaker (920) or a voice receiving section of the handset (110) that an awaiting state is kept at a time of a response to an incoming call until a voice of a

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part placing the call is heard through the speaker (920) [Fig. 11; Abstract; col. 6, lines 19-31; col. 6, lines 41-52; col. 8, lines 1-9; col. 10, lines 8-15; col. 10, lines 28-37; col. 12, lines 38-41; col. 14, lines 51-65; col. 16, lines 15-41; col. 17, lines 19-30].

Claim 9 is essentially similar to Claim 1 and is rejected for the reasons stated above apropos of Claim 1.

Regarding claim 2, Peterson et al teach the telephone set (100), wherein the notifying/instructing unit (900) used to make an instruction unit to continuously notify a user via the speaker (920) or a voice receiving section of the handset (110) that an awaiting state is kept at a time of a response to an incoming call until a voice of a part placing the call is heard through the speaker (920) [Fig. 11; col. 8, lines 1-9; col. 10, lines 8-15; col. 12, lines 38-41; col. 14, lines 51-65; col. 16, lines 15-41; col. 8, line 64 to col. 9, line 21].

Claim 10 is essentially similar to Claim 2 and is rejected for the reasons stated above apropos of Claim 2.

Regarding claim 3, Peterson et al teach the telephone set (100) comprising a unit (900) used to generate the predetermined signal voice (i.e. **distinctive voice**) [col. 11, line 60 to col. 12, line 16].

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Claim 11 is essentially similar to Claim 3 and is rejected for the reasons stated above apropos of Claim 3.

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Regarding claim 4, Peterson et al teach the telephone set (100), wherein the notifying/instructing unit (900) used to make an instruction unit to transmit a predetermined display signal and to continuously notify a user via the speaker (920) or a voice receiving section of the handset (110) that an awaiting state is kept at a time of a response to an incoming call until a voice of a part placing the call is heard through the speaker (920) [Fig. 11; col. 8, lines 1-9; col. 10, lines 8-15; col. 12, lines 38-41; col. 14, lines 51-65; col. 16, lines 15-41; col. 8, line 64 to col. 9, line 21; col. 2, lines 4-18].

Claim 12 is essentially similar to Claim 4 and is rejected for the reasons stated above apropos of Claim 4.

Regarding claims 5, 13, the limitations are shown above.

Regarding claim 6, Peterson et al teach the telephone set (100), wherein the notifying/instructing unit (900), after having stopped transmission of the incoming call, continuously notifies the user via the speaker (920) or a voice receiving section of the handset (110) that an awaiting state is kept at a time of a response to an incoming call until a voice of a part placing the call is heard through the speaker (920) [Fig. 11; col. 1, lines 31-43; col. 2, lines 19-27; col. 8, lines 1-9; col. 10, lines 8-15; col. 12, lines 38-41; col. 14, lines 51-65; col. 16, lines 15-41; col. 8, line 64 to col. 9, line 21; col. 2, lines 4-18].

Claim 14 is essentially similar to Claim 6 and is rejected for the reasons stated above apropos of Claim 6.

Regarding claim 7, Peterson et al teach the telephone set (100), wherein the notifying/instructing unit (900), after the transmission of the incoming call has been stopped by ether an off-hook operation of a handset or a monitor-on operation of a speaker, continuously notifies the user via the speaker (920) or a voice receiving section of the handset (110) that an awaiting state is kept at a time of a response to an incoming call until a voice of a part placing the call is heard through the speaker (920) [Fig. 11; col. 6, lines 41-52; col. 8, lines 1-9; col. 10, lines 8-15; col. 12, lines 38-41; col. 14, lines 51-65; col. 16, lines 15-41; col. 8, line 64 to col. 9, line 21; col. 2, lines 4-18].

Claim 15 is essentially similar to Claim 7 and is rejected for the reasons stated above apropos of Claim 7.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



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9. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson et al as applied to claims 1, 9 above, and further in view of Kung et al [US 6,633,635 B2].

Regarding Claim 8, Peterson et al teach different types of telephones [col. 6, lines 41-52; col. 5, line 66 to col. 6, line 5]. However, they do not teach expressly an internet protocol (IP) telephone set.

Kung et al teaches multiple call waiting in a packetized communication system , as shown in Figs.1-3, including a broad-band IP-based network [col. 1, lines 9-15] , comprising a broadband residential gateway (BRG) 300 [col. 3, line 30 to col. 4, line 58] ; an announcement server 220 [col. 9, lines 39-46]; and a voice gateway 232 [col. 12, lines 53-67]. Fig. 3 shows a block diagram of a local control apparatus (broadband residential gateway) which can support **IP telephones** [col. 21, lines 41-61]. Further, Kung et al discloses implementing a call queue function wherein the subscriber may use any type of broadband communication device including POTS phone [Abstract; col. 32, lines 49-51].

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Peterson et al and Kung et al are analogous art because they are from a similar problem solving area, viz. , telephonic communications.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the IP telephone set with Peterson et al.

The suggestion/motivation for doing so would have been to provide multiple call waiting in an Internet Protocol Telephony Network [col. 1, lines 53-58].

Claim 16 is essentially similar to claim 8 and is rejected for the reasons stated above apropos of claim 8.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) Gerszberg et al [US 6,396,531] shows a video phone [Fig. 3A; col. 12, line 39 to col. 13, line 17].

**11. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramnandan Singh whose telephone number is (703)308-6270. The examiner can normally be reached on M-F(8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester Isen can be reached on (703)-305-4386. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramnandan Singh  
Examiner  
Art Unit 2644



FORESTER W. ISEN  
SUPERVISORY PATENT EXAMINER